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FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
03/23/1999	MASAHITO TANAKA	445-271P	2395

2292 7590 08/09/2002

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EXAMINER

REICHLE, KARIN M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/147,894

Applicant(s)

TANAKA ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-11, 15 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, 15 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6-13-02 has been entered.

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

3. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 5, amendment to line 5, line 1, thereof, i.e. "on" should be --by--.

4. The disclosure is objected to because of the following informalities: The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims is not consistent in scope, see MPEP 608.01(d) and 1302.01. For example, where are the single absorbent sheet integrally folded with the topsheet to form the cuffs and a projecting portion as claimed in claim 1 set forth?

Appropriate correction is required.

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5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention of claims 3, 5, 15, 20, 22-23 and 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Contrary to Applicant's arguments Figure 3 does not show the combination of all the features claimed in claim 3.

6. It is noted that the marked up version of claim 5 does not comply with 37 CFR 1.121 because it does not show all the changes made to the previous claim 5 to arrive at the new claim 5. Any further response must include a correct marked up copy of claim 5 or such response will be held nonresponsive.

7. Claims 7, 15, 20, 22-23 and 25-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As interpreted in light of the specification, the absorbent member nor the single absorbent sheet is required to be only one layer. If not, where is the support for claim 7, lines 1-3? Likewise, the projecting portion set forth in claim 1 is interpreted as being an absorbent pad. If not, where is the support for the absorbent pad as

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claimed in claim 15 in addition to a projecting portion. In claim 20, the projecting portion and the auxiliary pad are interpreted to be one and the same. If not, where is the support for a single pad and auxiliary pad and a projecting portion? Where is the support for claims 22-23, note the language "said second absorbent member"?

8. Claim 7 is objected to because of the following informalities: In claim 7, line 3, "paper" should be --papers-- and "fabric" should be --fabrics--. Appropriate correction is required.

9. Claims 1-3, 5-11, 15, and 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, is the absorbent sheet part of the absorbent member or not? This also applies to claims 19 and 20. In regard to claim 15, are the absorbent pad and the projecting portion one and the same? In regard to claim 20, are the auxiliary pad and the projecting portion one and the same? In regard to claims 22 and 23, is the description "of said second absorbent member accurate? In claim 20, the description of the single pad as being both planar, line 9, and being folded, line 13, is inconsistent.

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. It is noted that "barrier" is defined as "something that acts to hinder or restrict" as defined by the American Heritage Dictionary. Each of the following prior art devices includes laterally

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located portions which are absorbent and extend along longitudinal edges, and thereby if not explicitly described as such, inherently perform, have the capability or function as barrier cuffs.

12. Claims 1, 8, 10, 15 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Runeman et al.

See Figures, especially Figure 3, i.e top layer, 1, back layer, 2, absorbent layer or sheet 4, barrier cuffs, adjacent 1 and 6 in Figure 3, pocket portion between cuffs, projecting portion, upper portion of 5, means for bonding, see col. 3, lines 5-8(note claims do not require direct bonding) and absorbent pad, 5. As discussed supra, the claims do not require that the absorbent member only includes a single layered absorbent sheet forming cuffs with the topsheet.

13. Claims 1-3, 8-11, 15 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Roessler et al.

See Figures 3-5, i.e. top layer 25, back layer 24, absorbent layer or sheet, upper layer 50, barrier cuffs, adjacent 44 as seen in figure 3, and see col. 10, lines 23-27, pocket portion, 47, projecting portion 52, means for bonding, col. 10, lines 11-14, absorbent pad, lower layer of 53, thickness, see col. 10, lines 58-60 and col. 12, line 1, elastic members, col 7, line 63-col. 8, line 43. Again the claims do not require that the absorbent member includes only a single layered absorbent sheet forming cuffs with the topsheet.

14. Claims 1, 3, 8-11, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura et al, JP '553.

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See Figures 4 and 12, and page 8, first full paragraph of translation: top layer, 1, back layer, 2, absorbent layer or sheet 3a and 3 at ends, cuffs, adjacent 3a, pocket portion, between 8 in Figure 4, projecting portion, 3 between 8, elastic portions, 11, bonding means, see page 5, lines 1-8 of translation.

15. Claims 2 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al in view of Canadian International.

Applicants claim the thickness of the barrier cuffs and absorbent sheet of the absorbent article, i.e. a diaper, which Yoshimura et al does not teach. However, see col. 3, lines 28-52 of Canadian International. To employ the dimensions as taught by Canadian International on the Yoshimura et al device would be obvious to one of ordinary skill in the art in view of the recognition that such would ensure efficient reception and retention of body fluids and the desirability of such by Yoshimura et al, e.g. see page 8, lines 16-20 of translation.

16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura and Canadian International as applied to claim 5 above, and further in view of Roessler et al '342, Molnlycke '582 and P & G '326.

Applicants claim the composition of the absorbent sheet while Yoshimura only teaches an absorbent sheet. See, however, Canadian International, i.e. hydrophilic fiber, i.e. wood pulp, Roessler et, col. 9, line 3-col. 10, line 3 and col. 10, lines 49-57, and Molnlycke, paragraph bridging pages 6-7 and P & G, page 9, lines 20-28. To make the absorbent sheet of Yoshimura et al the claimed composition would be obvious to one of ordinary skill in the art in view of the

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conventionality of and interchangeability of absorbents as taught by Canadian International, Roessler et al, Molnlycke and P & G.

17. Claims 19-20, 22-23 and 25-26 patentably distinguish over the prior art of good date, before 10-23-96, alone or in any combination, because it does not teach the structure of lines 6 et seq of claims 19 and 20 in combination with the other structure claimed in those claims.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Th cited prior art teaches variously formed cuffs.

19. Applicant's remarks have been considered but have either been addressed supra, are deemed moot in that the discussed issue has not been reraised, or are deemed nonpersuasive because the amendments do not remove the informalities detailed supra or raise new issues or are narrower than the claim language and the teachings of the prior art, see prior art rejections supra.

20. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday.

KMR

K. M. Reichle
Karin M. Reichle
Patent Examiner

August 6, 2002